

REMARKS

A. Claims 1-3, 14 and 15 were rejected under 35 U.S.C. §102(b) as being anticipated by Van Cruyningen (US %,805,167). The applicant respectfully traverses this rejection for the following reason(s).

First, note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in Van Cruyningen.

The claims require a plurality of menu icons being individually selectable for enabling a user to adjust a display state of the display section. None of the menu icons in Van Cruyningen are for the adjustment of the **display state of the display section**. It is well known in the art that the display state of the display section refers to various adjustments such as color, brightness, contrast, vertical size, etc. None of the menu icons in Van Cruyningen are related to the adjustment of the display state of the display section. Instead, they are related to the editing of a document being worked on.

Second, the amendment to claims 1 and 14 incorporate the features of claims 4 and 16, respectively, thereby rendering the rejection moot, since neither of claims 4 and 16 were rejected

under §102.

B. Claims 4, 5 and 16 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Van Cruyningen in view of Miller (US 6,613,100). The Applicant respectfully traverses this rejection for the following reason(s).

First, Miller, like Van Cruyningen, fails to teach a plurality of menu icons being individually selectable for enabling a user to adjust a display state of the display section. Miller provides thumbnails 270 for selection by the user. These thumbnails 270 are miniaturized graphical representations of documents that may be relevant to the current document displayed on the display panel 260. Essentially, the thumbnail 270 is a minuscule picture of an actual document, which serves to uniquely identify the document by mere visual inspection of the thumbnail 270. Thus there are no **menu icons** being displayed. There is no menu matrix being displayed in Miller.

Accordingly, the menu icons taught by Van Cruyningen and the thumbnails taught by Miller are not analogous to each other.

Second, the current document displayed on the display panel 260 is displayed in a central region surrounded by the thumbnails 270 because the thumbnails 270 are displayed in selection panels 220-250 that surround the display panel 260. There is no other location for displaying these thumbnails.

Nor is the document that is displayed on display panel 260 (the central panel) displayed because it is the document having the highest frequency of use. The Examiner clearly asserts that

Van Cruyningen "does not disclose the limitation of disposes the menu icon having the highest frequency of use at the central region of the menu matrix where the pointer is initially positioned."

Accordingly, neither reference teaches determining a frequency of use of each of the menu icons selected by a user to adjust a display state; and setting the menu icon having **the highest frequency of use as said default menu icon**.

Accordingly, one of ordinary skill in the art would not have looked to Miller for some teaching to improve Van Cruyningen's invention.

The Examiner offers a basis of obviousness by stating that one of ordinary skill in the art would include Miller's "teaching of current document is displayed in the center of the display device while the relevant documents surrounded on the border of the current document" into that of Van Cruyningen's invention, "[to allow the] user to focus on the centralized current document . . .". However, there are no "relevant documents" related to a current document in Van Cruyningen and the current document displayed in Van Cruyningen is already centralized because it takes up the whole window 40 and the user can advantageously view more information from the current document at one time. Besides, the claimed feature is directed towards menu icons, not a current document being worked on.

Accordingly, the Examiner's fails to provide a *prima facie* basis of obviousness. *In re Rijckaert*, 28 USPQ2d 1955 (CAFC 1993) states:

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rhinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d

1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, the rejection is deemed to be in error and should be withdrawn.

The indication of allowable subject matter with respect to claims 6, 7 and 17-20 is appreciated.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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